

Remarks/Arguments

Claims 1 to 44 are pending. Previously presented Claim 1 has been amended herein. Claims 2 to 6 and 12 to 20 have been canceled. New Claims 42 to 44 have been added.

Applicants request that any additional fees required be charged to Deposit Account No. 06-1110.

The Office Action stated: that restriction to one of the following inventions is required under 35 U.S.C. 121: I. Claims 1 to 6, 12 to 20, drawn to a coating film-stripping solution, classified in class 510, subclass 201; and II. Claims 7 to 11, 21 to 41, drawn to a coating-film-stripping method, classified in class 134, subclass 2.

In response, applicants note that during a telephone conversation with Virgil March on August 16, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 6, 12 to 20, Species (a) alkali metals, alkali metal compounds, and that applicants affirm this election at this time.

The Office Action stated: that the inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as product and process of use; that the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product; and that , in the instant case, the process of using that product as

claimed can be practiced with another materially different product such as a composition consisting of ethylene glycol monobutyl ether and isopropyl alcohol.

In response, applicants note that during a telephone conversation with Virgil March on August 16, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 6, 12 to 20, Species (a) alkali metals, alkali metal compounds, and that applicants affirm this election at this time.

The Office Action stated: that, because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper; that the application contains claims directed to the following patentably distinct species: a) alkali metals, alkali metal compounds; b) Phosphoric acids, phosphoric acid compounds; c) Organic acids and organic acid salts; and d) Amide compound; and that the species are independent or distinct because each species are different compounds.

In response, applicants note that during a telephone conversation with Virgil March on August 16, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 6, 12 to 20, Species (a) alkali metals, alkali metal compounds, and that applicants affirm this election at this time.

The Office Action stated: that applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable; that applicant

is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election; that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141; and that, if claims are added after the election, applicant must indicate which are readable upon the elected species.

In response, applicants note that during a telephone conversation with Virgil March on August 16, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 6, 12 to 20, Species (a) alkali metals, alkali metal compounds, and that applicants affirm this election at this time.

The Office Action stated: that, during a telephone conversation with Virgil March on August 16, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 6, 12 to 20, Species (a) alkali metals, alkali metal compounds; that affirmation of this election must be made by applicant in replying to this Office action; and that Claims 7 to 11 21 to 41 have withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

In response, applicants affirm this election to prosecute the invention of Group I, claims 1 to 6, 12 to 20, Species (a) alkali metals, alkali metal compounds at this time.

The Office Action stated: that applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application; and that any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants note that an amendment of inventorship is not required by the subject cancellation of claims to the non-elected invention.

Claims 1 to 6, and 12 to 20 have been rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 1 herein in accordance with the Examiner's specified concern. Claims 2 to 6, and 12 to 20 depend therefrom.

The Office Action stated: that Claim 1 is indefinite in the recital of "alkali metals" because these metals are not normally used in their metal forms; the Examiner inquires whether applicant means "alkali metal compounds"; and the Examiner suggests that "alkali metals" be deleted inasmuch as "alkali metal compounds" is already claimed.

In response, applicants note that the wording "alkali metals" is not present in Claim 1 as amended in this Amendment.

The Office Action stated: that Claims 2 to 6, and 12 to 20, being dependent upon claim 1, are rejected as well. The subject wording is no longer present in Claim 1 as amended herein.

Since applicants have amended claim 1 herein in accordance with the Examiner's specified concern, it is requested that this rejection of Claims 1 to 6, and 12 to 20 under U.S.C. 112, second paragraph, be withdrawn at present.

With regard to amended claim 1, applicants note that in amended claim 1, introduction of the description "aromatic solvent" was made based on the description on page 10, line 23.

Claims 1 to 5, and 12 to 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,518,675 (Kataoka). Applicants traverse this rejection.

The Office Action stated: that Kataoka teaches a stripper for a radiosensitive resist (see abstract) which consists of a 5% solution of ethoxysodium (sodium ethoxide) in ethanol (see Example 6, col. 4, lines 22-23); that Kataoka teaches the limitations of the instant claims; and that, hence, Kataoka anticipates the claims.

Applicants note, first of all, that the presently claimed invention can provide the following particular effects: The stripping substance has a function to break down crosslinking of the cured coating film to low molecules. The amide compound has a function to promote an action of the stripping substance such that the stripping substance can penetrate through the cured coating film and

efficiently break down the crosslinked film. The combination of the above functions can provide an effect showing good strippability.

A combined use of the stripping co-solvent further promotes penetration of the stripping substance into the cured coating film, resulting in improving strippability.

The coating film-stripping solution of the present invention can easily strip the cured coating film without damaging the coating object support, and can also strip the cured coating film in a short period of time without environmental pollution.

The cured coating film contacted with the coating film-stripping solution can be easily stripped from the substrate with water or the like.

The coating film-stripping solution and cured coating film adhered to the substrate after being stripped are easily removed, and the following operation such as coating can be carried out easily.

Now, with regard to this particular rejection, as stated in the Office Action, Kataoka teaches a stripper for a radiosensitive resist (see abstract) which consists of a 5% solution of ethoxysodium (sodium ethoxide) in ethanol (see Example 6, col. 4, lines 22 to 23). However, Kataoka does not teach a stripper containing, as an essential component, N-methyl-2-pyrrolidone as is claimed in amended claim 1 of the present invention.

Further, Kataoka does not teach a stripper containing, as an essential component, a stripping co-solvent consisting of a mixed solvent of a solvent (A) and a solvent (B) as is specified in amended claim 1 of the present invention.

Consequently, Kataoka does not teach a coating film-stripping solution containing, as essential components, sodium ethoxide, N-methyl-2-pyrrolidone, and the mixed solvent of the solvent (A) and the solvent (B) as defined in amended claim 1 of the present invention.

For these reasons, Claim 1 as amended herein is not anticipated by U.S. Patent No. 4,518,675 (Kataoka). And, Claims 2 to 5 and 12 to 16 have all been canceled in this Amendment. Thus, applicants request that this rejection under 35 U.S.C. 102(b) presently be withdrawn.

Claims 1 to 2, 4 to 5, 12, 14 and 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,073,287 (Harelstad). Applicants traverse this rejection.

The Office Action stated: that Harelstad teaches a paint stripper and/or organic coating remover composition which is formulated as follows: 5% by weight sodium methoxide, 15% by weight methyl alcohol and 80% by weight N-methyl-2-pyrrolidone (see Example 1, col. 4, lines 17-25); that Harelstad teaches the limitations of the instant claims; and that, hence, Harelstad anticipates the claims.

Applicants note that, as is stated in the Office Action, Harelstad teaches a paint stripper and/or organic coating remover composition which is formulated as follows: 5% by weight sodium methoxide, 15% by weight methyl alcohol and 80% by weight N-methyl-2-pyrrolidone (see Example 1, col. 4, lines 17 to 25).

That is, Harelstad teaches sodium methoxide, but does not teach sodium ethoxide as is claimed in amended claim 1 of the present invention.

Harelstad teaches methyl alcohol, but does not teach butanol to say nothing of a mixed solvent of a solvent (A) with a solvent (B) as is claimed in amended claim 1.

Applicants note that Harelstad does teach that the amount of sodium methoxide and methanol present in the solution correlates with the flash point of the composition, and that use of a solvent having a higher flash point such as ethylene glycol monobutylene is undesirable. However, Harelstad does not teach that a combined use of the stripping co-solvent with sodium ethoxide and N-methyl-2-pyrrolidone further promotes penetration of the stripping substance into the cured coating film, resulting in improving strippability as in the presently claimed invention.

Consequently, Harelstad does not teach a coating film-stripping solution containing, as essential components, sodium ethoxide, N-methyl-2-pyrrolidone, and the mixed solvent of the solvent (A) and the solvent (B) as defined in amended claim 1 of the present invention.

For these reasons, Claim 1 as amended herein is not anticipated by U.S. Patent No. 5,073,287 (Harelstad). And, Claims 2, 4, 5, 12, 14 and 16 have all been canceled in this Amendment. Thus, applicants request that this rejection under 35 U.S.C. 102(b) presently be withdrawn.

Claims 1, 4, 5, 6, and 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,411,378 (Sim). Applicants traverse this rejection.

The Office Action stated: that Sim teaches a paint-stripper composition comprising 30 wt% benzyl alcohol (equivalent to solvent A); 3 wt% pyrrole (equivalent to solvent B); 0.2 wt% sodium silicate and 0.1wt% sodium hydroxide (both being alkali metal compounds); that applicants should see Example 5, col.6, lines 56067; that applicants should see also Examples 6-13 under cols. 7 to 8; that Sim teaches the limitations of the instant claims; and that, hence, Sim anticipates the claims.

That is, Sim teaches benzyl alcohol, but does not teach butanol as is claimed in amended claim 1 of the present invention.

Sim teaches pyrrole, but does not teach aromatic solvent and paraffin solvent as is claimed in amended claim 1 of the present invention.

Sim teaches sodium silicate and sodium hydroxide, but does not teach sodium ethoxide as is claimed in amended claim 1 of the present invention.

Moreover, Sim does not teach N-methyl-2-pyrrolidone as is claimed in amended claim 1 of the present invention.

Consequently, Sim does not teach a coating film-stripping solution containing, as essential components, sodium ethoxide, N-methyl-2-pyrrolidone, and the mixed solvent of the solvent (A) and the solvent (B) as defined in amended claim 1 of the present invention.

For these reasons, Claim 1 as amended herein is not anticipated by U.S. Patent No. 5,411,378 (Sim). And, Claims 4, 5, 6 and 16 have all been canceled in this Amendment. Thus, applicants request that this rejection under 35 U.S.C. 102(b) presently be withdrawn.

Claims 1, 4, 5, 6 and 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by EP 0,903,381 (Nercissiantz et al.), hereinafter "Nercissiantz". Applicants traverse this rejection.

The Office Action stated: that Nercissiantz teaches a paint-stripper composition comprising 19.45 wt% benzyl alcohol (equivalent to solvent A); 1.5 wt% pyrrole (equivalent to solvent B); 3.00wt% sodium silicate and 0.25 wt% sodium hydroxide (both being alkali metal compounds); that applicants should see Examples IV on page 10, lines 1 to 29; that Nercissiantz teaches the limitations of the instant claims; and that, hence, Nercissiantz anticipates the claims.

Applicants note that, as stated in the Office Action, Nercissiantz teaches a paint-stripper composition comprising 19.45 wt% benzyl alcohol (equivalent to solvent A); 1.5 wt% pyrrole (equivalent to solvent B); 3.00 wt% sodium silicate and 0.25 wt% sodium hydroxide (both being alkali metal compounds), see Example IV on page 10, lines 1 to 29.

That is, Nercissiantz teaches benzyl alcohol, but does not teach butanol as is claimed in amended claim 1 of the present invention.

Nercissiantz teaches pyrrole, but does not teach aromatic solvent and paraffin solvent as is claimed in amended claim 1 of the present invention.

Nercissiantz teaches sodium silicate and sodium hydroxide, but does not teach sodium ethoxide as is claimed in amended claim 1 of the present invention.

Moreover, Nercissiantz does not teach N-methyl-2-pyrrolidone as is claimed in amended claim 1 of the present invention.

Consequently, Nercissiantz does not teach a coating film-stripping solution containing, as essential components, sodium ethoxide, N-methyl-2-pyrrolidone, and the mixed solvent of the solvent (A) and the solvent (B) as defined in amended claim 1 of the present invention.

For these reasons, Claim 1 as amended herein is not anticipated by EP 0,903,381 (Harelstad). And, Claims 4, 5, 6 and 16 have all been canceled in this Amendment. Thus, applicants request that this rejection under 35 U.S.C. 102(b) presently be withdrawn.

The Office Action stated: that this application currently names joint inventors; that, in considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary; and that applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

In response, applicants so note their obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made.

Claims 2, 3, 12 to 15, and 17 to 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sim as applied to the above claims. Applicants traverse this rejection.

The Office Action stated: that Sim teaches the features as described above; and that, in addition, Sim teaches that alkalinity agents can also be incorporated into the paint-stripping composition such as sodium ethoxide to neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. (see col. 5, lines 21-33); and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate sodium ethoxide into the paint-stripping composition because this would neutralize the acidity contributed by some components such as inhibitors, thickeners, and surfactants, etc. as taught by Sim.

Applicants note, in response, that Sim teaches that sodium ethoxide is used as the alkalinity agent, but does not teach that sodium ethoxide is used as the stripping substance to break down crosslinking of the cured coating film to low molecules as in the present invention.

Further, Sim teaches the paint-stripping composition comprising benzyl alcohol, pyrrole, and sodium ethoxide, but does not teach a coating film-stripping solution containing, as essential components, sodium ethoxide, N-methyl-2-pyrrolidone, and the mixed solvent of the solvent (A) and the solvent (B) as defined in amended claim 1 of the present invention.

As is stated in the Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate sodium ethoxide into the paint-stripping composition because this would neutralize the acidity contributed by some components, such as, inhibitors, thickeners, surfactants, etc. as taught by Sim.

However, for the grounds specified above, it would have been unobvious to one of ordinary skill in the art at the time the invention was made to arrive at the invention as claimed in amended claim 1 of the present invention from the above teachings of Sim. And, Claims 2, 3, 12 to 15 and 17 to 20 have been canceled in this Amendment.

Thus, applicants assert that this rejection of Claims 2, 3, 12 to 15 and 17 to 20 under 35 U.S.C. 103(a) as being unpatentable over Sim should be withdrawn at present.

Claims 2, 3, 12 to 15, and 17 to 20 have been rejected under U.S.C. 103(a) as being unpatentable over Nercissiantz as applied to the above claims. Applicants traverse this rejection.

The Office Action stated: that Nercissiantz teaches the features described above; that, in addition, Nercissiantz teaches that alkalinity agents can also be incorporated into both paint-stripping composition such as sodium ethoxide to neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. (see page 6, line 56 to page 7, line 5); and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate sodium ethoxide into the paint-stripping composition because this would neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. as taught by Nercissiantz.

Applicants note, in response, that Nercissiantz teaches that sodium ethoxide is used as the alkalinity agent, but does not teach that sodium ethoxide

is used as the stripping substance to break down crosslinking of the cured coating film to low molecules as in the present invention.

Further, Nercissiantz teaches the paint-stripping composition comprising benzyl alcohol, pyrrole, and sodium ethoxide, but does not teach a coating film-stripping solution containing, as essential components, sodium ethoxide, N-methyl-2-pyrrolidone, and the mixed solvent of the solvent (A) and the solvent (B) as defined in amended Claim 1 of the present invention.

Moreover, Nercissiantz does not teach the particular effects of the present invention as above-mentioned.

As is stated in the Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate sodium ethoxide into the paint-stripping composition because this would neutralize the acidity contributed by some components, such as, inhibitors, thickeners, surfactants, etc. as taught by Nercissiantz.

However, for the grounds specified above, it would have been unobvious to one of ordinary skill in the art at the time the invention was made to arrive at the invention as claimed in amended claim 1 of the present invention from the above teachings of Nercissiantz. And, Claims 2, 3, 12 to 15 and 17 to 20 have been canceled in this Amendment.

Thus, applicants assert that this rejection of Claims 2, 3, 12 to 15 and 17 to 20 under 35 U.S.C. 103(a) as being unpatentable over Sim should be withdrawn at present.

Claims 3, 6, 13, 15, and 17 to 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Harelstad as applied to the above claims in the view of Sim. Applicants traverse this rejection.

The Office Action stated: that Harelstad teaches the features as described above; that Harelstad, however, fails to specifically disclose sodium ethoxide, and a mixed solvent of a solvent as having a water-solubility of 5% by weight or more with a solvent B having a water-solubility less than 5% by weight; that Sim, in an analogous art, teaches the equivalency of sodium methoxide and sodium ethoxide (see col. 5, lines 25-27), and also teaches a mixed solvent comprising benzyl alcohol and pyrrole (which meets the water solubility requirements of solvent A and B, respectively), see col. 6, lines 56-67; and that it would have been obvious to one ordinary skill in the art at the time the invention was made to substitute sodium methoxide with sodium ethoxide because the substitution of art recognized equivalents as shown by Sim is within the level of ordinary skill in the art, and to incorporate benzyl alcohol and pyrrole into the composition because it is *prime facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.

Applicants note, in response, that the Office Action states that Sim, in an analogous art, teaches the equivalency of sodium methoxide and sodium ethoxide (see col. 5, lines 25 to 27).

In connection therewith, the above equivalency is as the alkalinity agent.

On the other hand, Harelstad teaches that the amount of sodium methoxide has a direct effect on the tank life of the composition, as well as the low flammability of the solution.

That is, the purpose of using sodium ethoxide in Sim is quite different from that of using sodium methoxide in Harelstad.

Therefore, it would have been unobvious to one of ordinary skill in the art at the time the invention was made to substitute sodium methoxide with sodium ethoxide.

In fact, even if sodium methoxide was substituted with sodium ethoxide, it would have been impossible to one of ordinary skill in the art at the time the invention was made to arrive at the invention as claimed in amended claim 1 of the present invention, because both Harelstad and Sim do not teach the mixed solvent of solvent (A) and solvent (B) as specified in amended claim 1 of the present invention.

The Examiner indicated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate benzyl alcohol and pyrrole into the composition.

In connection therewith, Harelstad teaches that the amount of sodium methoxide and methanol present in the solution correlates with the flash point of the composition, and that use of a solvent having a higher flash point such as ethylene glycol monobutylether is undesirable.

Therefore, it would have been unobvious to one of ordinary skill in the art at the time the invention was made to incorporate benzyl alcohol and pyrrole into the composition.

In fact, even if benzyl alcohol and pyrrole are incorporated into the composition, it would have been impossible to one of ordinary skill in the art at the time the invention was made to arrive at the invention as claimed in amended claim 1 of the present invention, because both Harelstad and Sim do not teach the mixed solvent of solvent (A) and solvent (B) as specified in amended claim 1 of the present invention.

For these reasons, Claim 1 as amended herein is not rendered unpatentable as obvious over U.S. Patent No. 5,073,287 (Harelstad). And, Claims 3, 6, 13, 15 and 17 to 20 have all been canceled in this Amendment. Thus, applicants request that this rejection under 35 U.S.C. 103(a) presently be withdrawn.

In conclusion, applicants note that, as above-mentioned, it is believed that amended claim 1, and new claims 42 to 44 should not be rejected under 35 U.S.C. 102(b) as being anticipated by Kataoka, Harelstad, Sim or Nercissiantz, and that amended claim 1, and new claims 42 to 44 should not be rejected under 35 U.S.C. 103(a) as being unpatentable over Sim as applied to the above claims, Nercissiantz as applied to the above claims, or over Harelstad as applied to above claims in view of Sim.

Again, applicants request that any additional fees required be charged to Deposit Account No. 06-1110.

Reconsideration, reexamination and allowance of the claims are
respectfully requested at present.

Respectfully submitted,

11/28/06
Date

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CERTIFICATE OF MAILING

I certify that this Amendment dated November 28, 2006, is
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